

Re: U.S. Patent Appln./Serial No. 10/632,561
Docket No. D-US-JK-01243

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DATE: December 26 2007

TO: COMMISSIONER FOR PATENTS
COMPANY: UNITED STATES PATENT & TRADEMARK OFFICE
FAX NO.: (571) 273-2885

MAIL STOP: RESPONSE

TOTAL PAGES (INCLUDING COVER SHEET): 5

FROM: Adan Ayala, Reg. No. 38,373
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Serial No. 10/632,561

Resp. to Off. Action of Oct. 3, 2007

UTILITY PATENT

B&D No. JK01243

IN THE UNITED STATES PATENT AND TRADEMARK OFFICERECEIVED
CENTRAL FAX CENTER

In re application of: Jaime GARCIA et al.

DEC 26 2007

Serial No.: 10/632,561

Examiner: C. Dexter

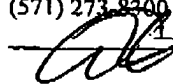
Filed: July 31, 2003

Group Art Unit: 3724

For: OPTICAL ALIGNMENT SYSTEM

Assistant Commissioner for Patents
Washington, DC 20231RESPONSE

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 273-8300 on 12-26-07



Adan Ayala

Dear Sir:

This is in response to the Office action of October 3, 2007.

Currently in the above-identified application are Claims 21-25 and 35-41.

The Examiner has rejected Claim 35-36 under 35 USC § 103(a) as being unpatentable over US Patent No. 6,481,322 ("Hsiung"). This rejection is respectfully traversed.

As admitted by the Examiner, Hsiung does not disclose the cutting device having the rotational axis disposed below the support surface. Instead, it shows the rotational axis to be disposed above the support surface, as found in miter saws.

The Examiner alleges that "it would have been obvious to one having ordinary skill in the art to provide such rotational support configuration on the the saw of Hsiung to gain the well known benefits including those described above," referring to the teachings of However, US Patent Nos. 1,336,501 ("Blanckensee"), 1,730,938 ("Kleeb"), 1,807,120 ("Lewis"), 3,130,621

Serial No. 10/632,561

Resp. to Off. Action of Oct. 3, 2007

UTILITY PATENT

B&D No. JK01243

("Else"), and 3,540,338 ("McEwan"). However, in all these references, the rotational axis of the blade are (a) disposed above the support surface, and (b) outside of the perimeter of the blade.

By contradistinction, Claim 35 requires that "the cutting device [have] a rotational axis disposed below the support surface." Accordingly, modifying Hsiung according to the teachings of Blanckensee, Kleeb, Lewis, Else or McEwan, will not provide the claimed arrangement.

The Examiner responded that "it would have been an obvious matter of design choice to modify Hsiung by providing the rotational axis at, above or below the support surface since applicant has not disclosed that having the rotational axis at a specific location (i.e., below the support surface) solves any stated problem or is for any particular purpose, and it appears that the saw would perform equally well with the rotational axis disposed at any vertical location relative to the support surface." This is incorrect.

Basically, Applicants are claiming a table saw. When using a table saw, a user feeds a workpiece into the blade, which cuts the workpiece as the workpiece is moved past the blade. Accordingly, a user can cut a workpiece of any size, whether a few inches long or several miles long, by passing it through the blade. Such linear cutting ability is not limited by the blade diameter. It is well known in the art that this arrangement is achieved by having the rotational axis of the blade disposed below the table, so as to not provide any major portions of the saw assembly that would prevent the workpiece passing past the blade.

On the other hand, a workpiece is disposed on a miter saw against a fence, so the workpiece does not move. Instead, the blade is brought down into the workpiece for cutting. Because the workpiece does not move, and the blade is brought down, the cutting capacity is limited by the size of the blade arm and/or the length of any forward motion of the blade.

Serial No. 10/632,561

Resp. to Off. Action of Oct. 3, 2007

UTILITY PATENT

B&D No. JK01243

In other words, persons skilled in the art will recognize that the saw would not perform equally well with the rotational axis disposed above the support surface and within the blade perimeter.

Furthermore, to take the miter saw configuration and convert it into a table saw, because such saw "would perform equally well" would violate the Federal Circuit precedent and the MPEP requirements. If a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then no suggestion or motivation exists to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (*quoted by* MPEP § 2143.01(V)).

In the present case, the purpose of the Hsiung miter saw (and all miter saws) is to provide an accurate cut. Accordingly, the Hsiung miter saw would be used as follows: a user places workpiece 4 against the vertical fence and lowers the saw assembly (and thus blade 11) into contact with workpiece 4 for cutting. Because workpiece 4 is held firmly against the fence and the rotation of blade 11 pushes workpiece 4 into the fence, the workpiece 4 does not move during the cutting operation, providing for a very accurate cut.

However, if the rotational axis of blade 11 were to be disposed below the support surface as suggested by the Examiner, the user would not be able to lower the saw assembly (and thus blade 11) into contact. Furthermore, the rotation of blade 11 would move the workpiece away from the fence, allowing workpiece 4 to move and causing an inaccurate cut. Accordingly, because the suggested modification would render the Hsiung miter saw unsatisfactory for its intended purpose, then no suggestion or motivation can exist to make the proposed modification, under present Federal Circuit law.

Serial No. 10/632,561

Resp. to Off. Action of Oct. 3, 2007

UTILITY PATENT

B&D No. JK01243

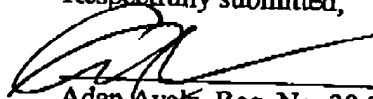
Furthermore, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then no suggestion or motivation can exist to make the proposed modification. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (*quoted by* MPEP § 2143.01(VI)). As discussed above, the user would use the Hsiung miter saw by pushing the workpiece 4 against to the fence (to minimize movement of workpiece 4) and lowering the saw assembly (and blade 11) into contact with workpiece 4.

If Hsiung were to be converted into a table saw as suggested by the Examiner, the workpiece 4 would be moved and pushed into blade 11, as is standard table saw cutting practice. Accordingly, the way the cutting operation is conducted is substantially modified, to the extent it changes the principle of operation of the miter saw. Therefore, no suggestion or motivation can exist to make the proposed modification.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 21-25 and 35-41 are respectfully requested.

No fee is due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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